

In re Application of: Yoav KIMCHY et al.
Serial No.: 10/616,301
Filed: July 10, 2003
Office Action Mailing Date: October 7, 2008

Examiner: Elmer M. CHAO
Group Art Unit: 3737
Attorney Docket: 25854

REMARKS

The present amendment is submitted in response to an Office Action issued on October 7, 2008.

The Application consists of claims 1-4, 6-19. Claims 9-15 are withdrawn from consideration. Claim 16 has been amended herewith. Claim 1 has been amended herewith to correct a typographical error. New claims 17-19 are have been added herewith. Claims 17 and 18 find support at least in Figs. 1-24 of the Application as filed. New claim 19 finds support at least on page 43, lines 27-32 of the Application as filed.

Election/Restriction

The Examiner indicates that claim 16 is directed to an invention that is independent or distinct from the invention originally claimed since claim 16 recites a method that does not necessarily require the device of claim 1.

Applicants amended claim 16 to include some structural terms and submit that the claim should now be searched along with claim 1 and be considered as having unity of invention therewith.

Claim Objections

Claims 1-4 and 6-8 stand objected since the term "radiopharmaceutical" is spelled incorrectly. In response thereto, Applicants corrected the term in claim 1. This amendment does not change the scope of the claimed invention. The objection is believed to be overcome by this amendment.

Double Patenting

Claims 1-4, 6 and 7 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending US Patent Application No. 10/240,239 in view of Houzego et al. (US Patent No. 6,632,216).

Claim 1 stands provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 9, 12 and 13 of copending US Patent Application No. 11/132,320 in view of Houzego et al.

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These rejections are provisional rejections as the conflict claims have not in fact been patented. Applicants will respond to these rejections when the cited applications will be allowed.

Claim Rejections – 35 U.S.C. §103

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Raylman et al. (US Patent No. 6,679,009) in view of Raylman et al. (US Patent No. 6,236,880). The Examiner states that Raylman '009 teaches all of the claimed features except for a sensor for determining the location and orientation of the ingestible device. According to the Examiner, this feature is taught by Raylman '880 and it would have been obvious at the time of the invention to automate the process of location and orientation of the tip of the ingestible device in order to free the operator of the task.

Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since Raylman '009 fails to teach additional claimed features and Raylman '880 fails to teach both the "missing" feature as indicated by the Examiner and the additional features which are not disclosed by Raylman '009.

Claim 1 is the only independent claim in this group of claims. Raylman '009 fails to teach at least one additional limitation of claim 1, namely "an ingestible device, arranged for traveling within a gastrointestinal tract of a body". Applicants submit that Raylman '009 does not teach an ingestible device. Raylman's device is configured to be grasped by the surgeon's hand during use, see col. 11, lines 5-19, "a housing that has a length such that a portion may be placed in a body while another portion of the same housing remains outside the body." Thus, the device of Raylman '009 is not adapted to be ingested into the body.

In addition, Raylman '880 does not teach an ingestible device. As described in col. 5, lines 13-23, the device of Raylman '880 also constitutes of a body portion and a handle portion. Moreover, Raylman '880 teaches away from using an ingestible device, since his device is adapted for replacing of the probe tips by the medical practitioner during the course of a procedure, as described in col. 3, lines 1-7. This

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could not be done with a device that is ingested, since it is not available to the practitioner during the procedure.

Thus, none of the cited reference teach an ingestible device, accordingly, claims 1-4, 6 and 7 are patentable over the art.

In addition, Applicants submit that, contrary to the Examiner's assertion, Raylman '880 fails to teach a "sensor adapted to determine the location and orientation of the ingestible device in the gastrointestinal tract".

The Examiner claims that this feature is found in col. 9, lines 62-67 of Raylman '880. Applicants have carefully reviewed the cited section and the document as a whole but failed to find such a feature. The cited section quotes: "To recapitulate, the present invention provides a probe system in which probe tips may readily be attached or detached from the distal end of a curved, preferably flexible tube that is affixed to the probe handle or body. The operator or other practitioner-user can thus adjust the orientation of an appropriate detector tip for the task at hand."

The cited section describes that due to the flexible tube (or wireless device as mentioned in other embodiments of the document), the operator can orient the device according to the task at hand. There is no hint to a sensor as claimed. In addition, applicants submit that there would be no reason to use such a sensor in Raylman '880 or Raylman '009 since in both the references the medical practitioner manually positions the device, such that the position is known to him. Contrary thereto, the present claims relate to an ingestible device which travels in the gastrointestinal tract. Such an ingested device tumbles inside the body. Without a sensor, there would be no indication of the position of the device.

It is therefore submitted that a combination of the references would be a device with a flexible cord (that is not ingested) where the medical practitioner orients the device. Thus, even if one would combine the references, and applicants state one wouldn't, the result would still differ from the claimed invention.

Accordingly, it is submitted that claims 1-4, 6 and 7 are patentable over the art. It is further submitted that claim 16 includes similar features of an ingestible device and determining the location and orientation of the ingestible device. Accordingly, claim 16 is also believed to be patentable over the cited art.

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The dependent claims are patentable at least by virtue of their patentable parent claim. In addition, at least new claims 17 and 18 add further patentability over claim 1. Claim 17 recites that the ingestible device is sized to be swallowed. As argues above, the devices of Raylman are sized to have a portion sticking out of the body and do not meet the claimed limitation. Claim 18 recites that the ingestible device is shaped as a pill. As shown in Fig. 1 of Raylman '009 and Fig. 4 of Raylman '880, the devices of Raylman are shaped as an L and not as a pill as claimed.

Claim stands rejected under 35 U.S.C. §103(a) as being unpatentable over Raylman '009 in view of Raylman '880 and further in view of Zhang et al. (Society of Nuclear Medicine, June 2000).

Claim 8 depends on claim 1. Applicants respectfully disagree with the rejection and submit that claim 8 is patentable at least by virtue of its patentable parent claim. It is further submitted that Zhang, like Raylman '009 and '880, does not teach an ingestible device. The imaging probe of Zhang is used in conjunction with CZT cameras located below and above the body (No. 68, Col. 1). Thus, Applicants reiterate that none of the cited art teaches an ingestible device as claimed.

In view of the above remarks, applicant submits that the claims are patentable over the prior art. Allowance of the application is respectfully awaited.

Respectfully submitted,



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Enclosures:

- ☐ Petition for Extension of Time (Three Months); and
- ☐ Additional Claims Transmittal Fee